

REMARKS

The examiner is thanked for a thorough examination of the present patent application.

Claims 7-12 are pending with Claim 7 being the sole independent claim. Claims 8-12 depend from, directly or ultimately, Claim 7.

I. NOTICE TO APPLICANT

Withdrawal of the Finality of the Office Action mailed December 13, 2004 is noted.

II. REJECTION OF UNDER 35 USC 103(a)

Claim 7 was rejected under U.S.C. 103(a) as being unpatentable over Ruby (U.S. Patent No. 5,873,153) in view of Sasaki (U.S. Patent No. 6,740,964). The applicant respectfully traverses.

For a valid rejection under 35 U.S.C. 103(a), “[t]he examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness.” MPEP 2142 (italic in the original; bold added). To establish a *prima facie* case of obviousness, three basic criteria must be met. **First**, there must be some suggestion or motivation to modify the reference. **Second**, there must be a reasonable expectation of success. **Finally**, the reference, when modified, must teach or suggest all the claimed limitations.” *See, e.g., In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991); MPEP 212 et seq. (emphasis added).

“Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either explicitly or implicitly in the references themselves or in the knowledge generally available to one of ordinary skill in the art.” MPEP 2143.01 citing *In re Kotzab*, 217 F.3d 1365, 1370, 55 USPQ2d 1313, 1317 (Fed. Cir. 2000). *See also*

In re Fine, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988); *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992) (emphasis added). Further, “[t]he level of skill in the art cannot be relied upon to provide the suggestion” to modify the references. *Al-Site Corp. v. VSI Int'l Inc.*, 174 F.3d 1308, 50 USPQ2d 1161 (Fed. Cir. 1999).

In fact, “[t]he mere fact that reference **can** be combined or modified does not render the resultant combination obvious **unless the prior art also suggests** the desirability of the combination.” MPEP 2143 citing *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990) (Emphasis added). In fact, there must be a suggestion or motivation **in the reference** to do so.” *In re Mills*, 916 F.2d at 682, 16 USPQ2d at 1432 (emphasis added).

The applicant respectfully submits that the rejection of Claim 7 should be withdrawn under **procedural grounds**.

Firstly, the rejection fails to even allege any motivation or suggestion to combine the cited references (Ruby and Sasaki). The best it can allege is that “the missing limitation is well known in the art because Sasaki discloses [it].” Office Action, p. 2. Surely, this is insufficient under the *In re Mills* requirement.

Secondly, the rejection fails to even allege any likelihood of success should the references be combined. Here, the rejection is completely silent.

Finally, the rejection fails to even allege that, even combined or modified, the references teach all allegations of the limitations of Claim 7. Claim 7 recites, *inter alia*, that “**a portion** of said bonding pad in contact with the substrate to form a Schottky diode.” (emphasis added). The rejection fails to even discuss this portion of Claim 7.

In light of the fact that the rejection fails to meet its burden to show a *prima facie* case of obviousness for being **procedurally insufficient**, the applicant respectfully submits that no further discussion is necessary for the allowance of Claim 7. However, to further assist the examiner in its review, the applicant respectfully submits, without prejudice, the following additional analysis:

The applicant respectfully submits that Claim 7 should be allowed under **substantive grounds**.

Firstly, there is no motivation or suggestion to combine the cited references (Ruby

and Sasaki). For this reason, the rejection fails to allege such motivation; further, the rejection fails to cite any portion of either of the cited references (Ruby and Sasaki) to assert the existence of such motivation or suggestion.

Secondly, there is no likelihood of success should the references be combined. In fact, neither of the cited references even recognizes the electro-static discharge protection solved by the present invention. Accordingly, there is no recognition of the problem, and there is no likelihood of success in such a problem.

Finally, the cited references, individually or in any combination, fail to teach that “a portion of said bonding pad in contact with the substrate to form a Schottky diode” as recited by Claim 7.

Accordingly, Claim 7 should be allowed under the substantive grounds.

The applicant respectfully submits that Claim 7 cannot be rendered obvious under the inherency argument of the Office Action. The rejection alleges “that the via metal contact 304 inherently forms a Schottky diode with the semiconductor substrate 301.” Office Action, p. 2. The applicant respectfully traverses.

“In relying upon the theory of inherency, **the examiner must provide a basis** in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic **necessarily** flows from the teachings of the applied prior art.” *Ex Parte Levy*, 17 USPQ2d 1461, 1464 (Bd. Pat. App. & Inter. 1990) (emphasis added). And, “[t]o establish inherency, the extrinsic evidence ‘must make clear’ that the missing descriptive matter is **necessarily present** in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. Inherency, however, may not be established by probabilities or possibilities. The **mere fact that a certain thing may result from a given set of circumstances is not sufficient.**” *In re Robertson*, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999) (citations omitted) (emphasis added).

Here, the office action’s assertion of inherency fails for multiple reasons, each of which is fatal to the rejection. First, the office action fails to provide any basis what so ever

for its assertion of inherency. Secondly, the office action fails to even assert that the allegedly inherent characteristic “necessarily flows” from the cited reference. Finally, the office action fails to assert any extrinsic evidence. The applicant respectfully submits that any one of these reasons is sufficient to render the reject invalid.

Claims 8-12 depend, directly or ultimately, on Claim 7. The applicant respectfully submits that Claims 8-12 are not rendered obvious by the Ruby reference, the Sasaki reference, or any combination of these for at least the same reasons for which these references fail to render obvious Claim 7 as discussed above. See, e.g., *In re Fine*, 837 F.2d 1071, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988).

In addition, similar procedural and substantive analyses apply to Claims 8-12 (similar to the procedural and substantive analysis applied to Claim 7 above). That is, for each of these Claims, the rejection is invalid

III. RELEVANT PRIOR ART REFERENCES NOT USED IN THE REJECTIONS

The applicant respectfully submits that Harada (U.S. Patent No. 6,417,575), individually or in any combination with the Ruby reference or the Sasaki reference, does not prevent allowance of Claims 7-12.

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Application no. 10/752,661
Response and Amendment on 10/14/2005;
in Reply to Office Action dated 07/14/2004

CONCLUSION

In view of the foregoing Remarks, the applicant respectfully submits that the entire application is in condition for allowance. The applicant respectfully requests that a timely Notice of Allowance be issued in this case.

Respectfully submitted,


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10/14/2005

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